

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/799,400	02/12/97	SASAKI	D KAMMON-3.0-0

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FM31/0521

EXAMINER

LEV, B

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 05/21/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/799,400

Applicant(s)
Sasaki et al

Examiner
Bruce A. Lev

Group Art Unit
3623



☒ Responsive to communication(s) filed on Apr 17, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-33 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-33 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 3623

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent of Sasaki et al 8,242,526 in view of Nimiya et al 4,933,512.

As concerns claims 1-28, and 31-33, Sasaki et al discloses the invention including a closure comprising a pair of semicylindrical sleeve members 1 vertically separable surrounding a cable connection section, wherein each has an abutting joint surface on the sides through which the sleeve members are joined; end plates 3 on opposite ends of the sleeve, each formed of rubber and having a cable guide hole 20; hinges and fasteners, inclusive of members 27,28,30,34, releasably hooked between and connecting the sleeve members; end plates formed with slits, inclusive of 22,25, extending from the guide holes to an outer periphery of the end plate; and guide hole caps 21 with rigidity holding members viewed as the surfaces between the cap and the holes. **What Sasaki et al does not show** is a gasket including an adhesive between the end plates and the sleeves. However, **Nimiya et al shows** gasket 60 including an adhesive, discussed in column 7 lines 15-20 and illustrated in figures 6a, 6b, and 7, between the end plates 40 and the sleeves 20. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the closure of Sasaki et al by incorporating a gasket including an adhesive between the end plates and the sleeves, as taught by Nimiya et al, in order to increase

Art Unit: 3623

the sealing capabilities between the plates and the sleeves, and to provide a secondary sealing means between the plates and the sleeves in case the inherent sealing capabilities of the plate fail.

As concerns claims 29,30 Sasaki et al 8,242,526 in view of Nimiya et al discloses the invention except for the gasket being made of thermoplastic rubber exhibiting a penetration, elongation, and tensile stress claimed. However, the examiner takes the position that since no engineering advantages have been disclosed for forming the gasket from these exact dimensions, and since it appears that various other dimensions would work equally as well, it would have been a mere design choice.

Response to Amendment

3. Applicant's remarks filed April 17, 1998 have been fully considered.

As concerns remarks pertaining to the amendment of claim 1 including changing the phrase "an adhesive tape-like gasket" to --a gasket including an adhesive--, the examiner points out that the specification must reflect this terminology (i.e. page 14, line 37).

As concerns remarks pertaining to the references of Rebers, and the combination of Rebers in view of Massey, the examiner, after further consideration, has withdrawn the pertinent rejections, and therefore the remarks are deemed moot.

As concerns remarks pertaining to the combination of Sasaki et al in view of Nimiya et al being unreasonable, the examiner points out that the test for obviousness is what the combined teachings of the references would have fairly suggested to those of ordinary skill in the art. See In

Art Unit: 3623

re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom (see *In re Preda*, 401 F.2d 825, 159 USPQ 342 (CCPA 1968)) and skill, rather than the converse, is presumed on the part of those of ordinary skill in the art (see *In re Sovish*, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985)). Also, as long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor (see *In re Beattie*, 974 F.2d 1309, 24 USPQ 2d 1040 (Fed. Cir. 1992)). The fact that the applicants have recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise have been obvious (see *Ex parte Obiaya*, 227 USPQ 58 (BPAI 1985), *aff'd mem.*, 795 F.2d 1017 (Fed. Cir. 1986)). In the instant case, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the closure of Sasaki et al by incorporating an gasket including an adhesive between the end plates and the sleeves, as taught by Nimiya et al, in order to increase the sealing capabilities between the plates and the sleeves, and to provide a secondary sealing means between the plates and the sleeves in case the inherent sealing capabilities of the plate fail. The fact that the applicants have, for all intents and purposes, incorporated a gasket including an adhesive into a previously existing configuration, lends support to the position that it would have been proper

Art Unit: 3623

to use the reference of Nimiya to teach the use of a gasket including an adhesive to the configuration of Sasaki et al.

As concerns remarks pertaining to the reference of Nimiya not teaching the use of a gasket including an adhesive, the examiner takes the position that Nimiya does teach the use of a gasket including an adhesive as discussed in column 7 lines 15-20 and illustrated in figures 6a, 6b, and 7, between the end plates 40 and the sleeves 20.

Conclusion

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

THIS ACTION IS MADE FINAL. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.


Serial Number: 08/799,400

Page 6

Art Unit: 3623

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce A. Lev whose telephone number is (703) 308-7470.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

bl 

February 27, 1998



DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
GROUP 3600